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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,385	02/18/2004	Satoshi Mizutani	20050/0200895-US0	3573
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DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			EXAMINER BOGART, MICHAEL G	
			ART UNIT 3761	PAPER NUMBER
			MAIL DATE 11/29/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/782,385

Applicant(s)

MIZUTANI ET AL.

Examiner

Michael G. Bogart

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,6,7,9-12,20,23,24,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6,7,9-12,20,23,24,26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 May 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Request for Continued Examination***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04 September 2007 has been entered.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show a longitudinal central line that is closer to a side of one of the sheet pieces than the other as described in the specification and recited in claim 1. While figure 1 shows a longitudinal line (m) that bisects the pad, the figures do not show that the longitudinal central line is located closer to one of the sheet pieces (30a, 30b) than the other. These sheet pieces appear to overlap the longitudinal axis by an equal amount (see figure 1B). Furthermore, this limitation implies that the longitudinal central line is located centrally in the Z-direction (thickness between first and second sheets) of the pad. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being

amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections – 35 USC § 103***

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 1, 6, 7, 9, 12, 20, 23, 24, 26 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mizutani *et al.* (WO 02/094148 A1; hereinafter "Mizutani"). For the purposes of illustration, all references are made to the English language equivalent document US 2004/0158222 A1.

Regarding claim 1, Mizutani teaches an interlabial pad (20) comprising:

a first sheet (21) forming a surface side sheet configured contacting a body, the first sheet (21) having a permeable property for liquid;

a second sheet (22) independent from the first sheet (21) and forming a back face side sheet configured to be positioned away from the body, the second sheet (22) including a plurality of sheet pieces (24A, 24B), each partially overlapping another sheet piece;

an absorbent body (23) for absorbing liquid, the absorbent body (23) being disposed between the surface side sheet (21) and the back face side sheet (22);

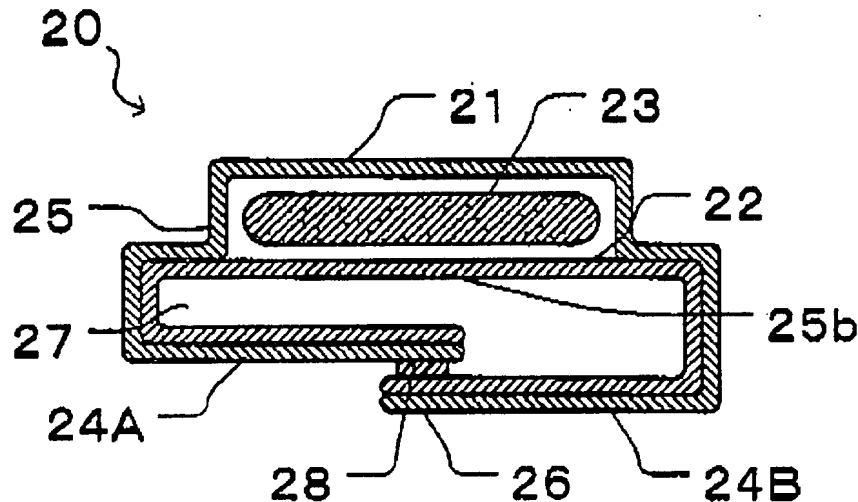
a junction joining the surface side sheet (21) and the back face side sheet (22) at a peripheral edge of the absorbent body (23);

at least one seam part (26) of the second sheet (22) formed by overlapping the plurality of sheet pieces (24A, 24B) over one another, the seam part (26) including:

a longitudinal seam part (26) extending in a longitudinal direction of the interlabial pad (20), crossing over the second sheet (22) from an edge to another edge of the second sheet (22)

and an adhesive agent (28) applied between the sheet pieces (24A, 24B) at the longitudinal seam part (26) along a longitudinal central line along the longitudinal direction, wherein the sheet piece (24A), which overlaps the other sheet piece (24B) at the longitudinal seam part (26) and which covers a side closer to the longitudinal central line of the interlabial pad (20), is positioned at the absorbent body (23) side of the second sheet (22) and wherein the sheet pieces (24A, 24B) are each formed of either a water disintegrable material or a biodegradable material to enable separation of the second sheet into the sheet pieces (24A, 24B) when discarded by flushing (§ 0074).

**FIG. 18**

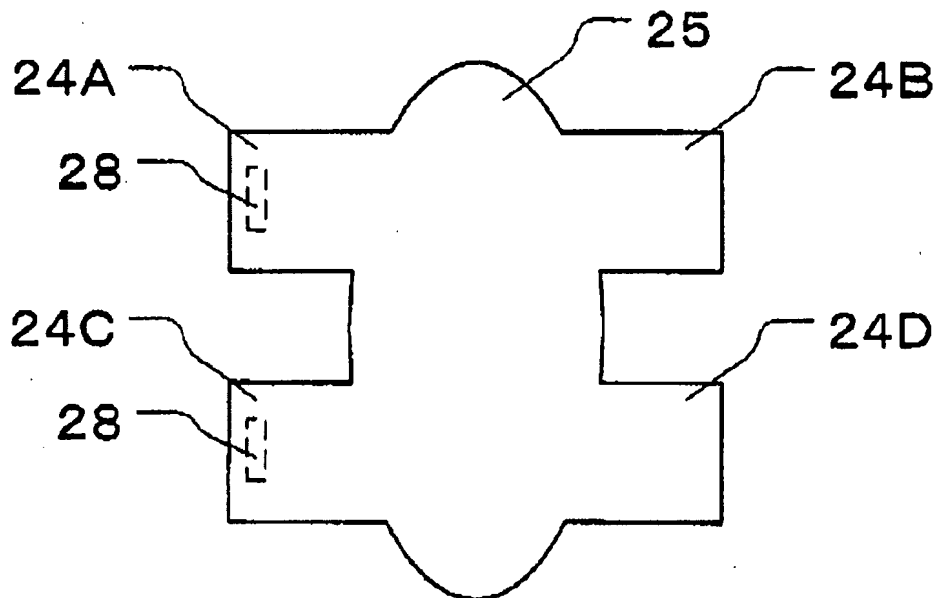


Mizutani does not disclose the specific dimension of the overlapping portions. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device

and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Regarding claims 6, 7 and 23, Mizutani teaches a lateral seam part (25) and a sheet piece (24A) overlapping a sheet piece (24B) at the seam part (see fig. 30, *infra*). Regarding the functional limitations of the claim, apparatus claims must be structurally distinguishable over the prior art. MPEP § 2114. The device of Mizutani can be folded in the claimed manner.

**FIG. 30**



Regarding claims 9 and 20, Mizutani teaches that the back face side sheet (22) is made uneven at least at the surface opposite the absorbent body (23) side (see fig. 18, *supra*).

Regarding claim 12, Mizutani teaches at least one parting zone (26) formed with the seam part (26) formed by the overlapping of the sheet pieces (24A, 24B).

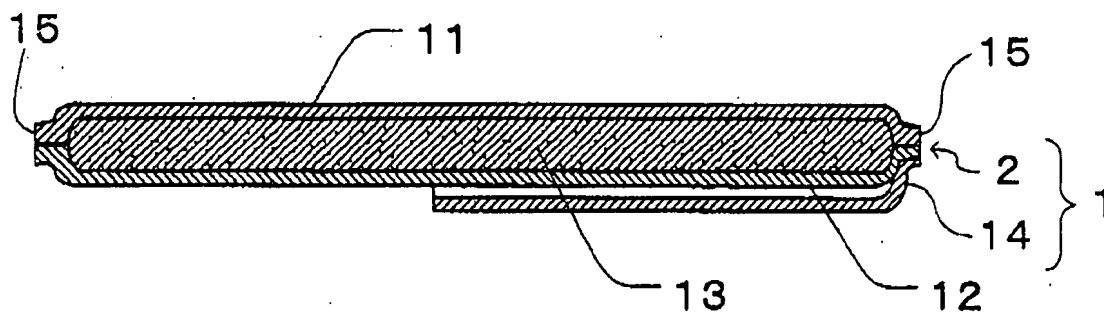
Regarding claim 24, Mizutani teaches that the back face side sheet (22) has two sheet pieces (24A, 24B).

Regarding claim 26, Mizutani does not teach the specific ranges of values for the basis weight of the adhesive. Generally, optimization of ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

One of ordinary skill in the art would have recognized that increasing the basis weight of adhesive would provide for increased adhesion while slowing dispersion in water.

Regarding claim 27, Mizutani teaches a mini sheet piece (14) attached at the junction (2) of sheets (11) and (12)(see fig. 1, *infra*).

FIG. 1



Claims 10 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mizutani as applied to claims 1, 6, 7, 9, 12, 20, 23, 24, 26 and 27 above, and further in view of Osborn, III (WO 99/26573 A1; hereinafter "Osborn").

Mizutani does not disclose expressly the packaging sheet.

Osborn teaches a packaging body (50) for a sanitary pad (20), comprising:

a packaging sheet (68); and

a sanitary pad (20) covered by the packaging sheet (68);

wherein the packaging sheet (68) is provided with a continuous or discontinuous parting zone that is parted by actions of water, along which the packaging sheet (68) is separated into a plurality of small sheet piece when water after the packaging sheet is discarded in the toilet (page 19, line 20-page 21, line 23)(see fig. 5).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the packaging of Osborn to package the pad of Mizutani in order to provide packaging that is known in the art to be suitable for that purpose.

Regarding the functional limitations, e.g., how the back side sheet disperses after placement in a toilet, apparatus claims must be structurally distinguishable over the prior art. MPEP § 2114. Osborn discloses packaging that can optionally be constructed of a dissolvable material. Even if the packaging is not torn open, it will eventually dissolve, even if this not an intended use of the disclosure.

Regarding claim 11, Osborn teaches that the packaging sheet is a liquid impermeable sheet (e.g., thermoplastic film) with an impermeable property against liquid (page 19, lines 20-31).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 6, 7, 9-12, 20, 23, 24, 26 and 27 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

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Michael Bogart  
23 November 2007

**Tatyana Zalukaeva, Ph.D.**  
**Primary Examiner**

